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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/584,640 05/31/00 LOOK

J 0630/06528

025291 QM02/0618  
AMERICAN HOME PRODUCTS CORPORATION  
PATENT SECTION  
FIVE GIRALDA FARMS  
MADISON NJ 07940-0874

EXAMINER

WALCZAK, D

ART UNIT

PAPER NUMBER

3751

DATE MAILED:

06/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/584,640

Applicant(s)

Look

Examiner

Walczak

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 3, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above, claim(s) 14-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 31, 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 20) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election without traverse of Group I in Paper No. 8 is acknowledged. It is noted that as Group II was not elected, an election of species was not needed. Accordingly, claims 1-13, which are readable on Group I, will be examined herein. Claims 14-50 are withdrawn.

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the alphanumeric numbers, other geometric shapes and combinations (claim 6) must be shown or the features canceled from the claim. No new matter should be entered.

### *Specification*

2. The disclosure is objected to because of the following informalities: On page 5, line 26, "8a" should be --8b-- as Figure 8b includes line 8c-8c. Appropriate correction is required.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the

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following is required: The subject matter in claims 8 and <sup>UP</sup>10 does not have antecedent basis in the specification.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 3-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Prince. In regard to claims 1, 3, 4m 5 and 12, the Prince reference discloses a multi-color stick product comprised of a container 16 having walls, an exterior contour and an interior contour and a molded multi-color stick composition disposed so as to contact the walls of the container and be advanced in the container wherein the stick includes a first composition 14 and a second composition 11 which differ in color, are arranged in a predetermined non-random image that is reproducible and which form a predetermined, discrete, multicolor image. In regard to claim 6, the image is a circle. In regard to claim 7, each cross-section of the stick contains the same image. In regard to claim 8, the stick is used for application. It is noted that the statements of intended use, i.e., for topical application to an animal, do not lend any patentable structure to the claims. Further, the Prince device can be used to apply substance to an animal is so desired by a user. In regard to claim 9, the stick composition is lipstick. In regard to claim 10, the

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composition includes a “pharmaceutically acceptable vehicle”. In regard to claim 11, the composition comprises a colorant. In regard to claim 13, the Prince stick composition is disclosed as being “any preparation to be applied to the surface of a human body .... For cleaning and conditioning the skin (column 2, lines 40-43). Accordingly, as lip balm is applied to human skin (the lips) and used for “conditioning” the lips, the Prince reference anticipates the use of lip balm.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prince in view of Gavin. Although the Prince device does not have interior and exterior contours which are different, attention is directed to the Gavin reference, which discloses another stick product wherein the interior and exterior contours of the container are different. Such arrangements are commonly employed in order to lend aesthetics to the device. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to design the Prince container such that the interior and exterior contours are different in order to improve the appearance of the device.

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8. Any inquiry to this Office Action should be directed to David Walczak at 703-308-0608.

D Walczak

6/12/01

  
**DAVID J. WALCZAK**  
**PRIMARY EXAMINER**